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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/791,391.     | 03/02/2004  | Alexander C. Chan    | J6887(C)            | 5144             |

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ENGLEWOOD CLIFFS, NJ 07632-3100

EXAMINER

ELHILO, EISA B

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1751

DATE MAILED: 08/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/791,391

Applicant(s)

CHAN ET AL.

Examiner

Eisa B. Elhilo

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 10-17 is/are rejected.
- 7) ☒ Claim(s) 6-9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/2/2004.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

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Claims 1-17 are pending in this action.

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4 and 10-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 9, 11 and 12 of copending Application No. 10/963332. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending Application No. 10/963,332 teach and disclose similar method for coloring hair comprising carrying out similar sequential steps of contacting the hair with a dye mixture comprising a primary intermediates and couplers such as p-phenylenediamines as claimed in claims 1-4 (see claims 1-2 of the copending Application No. 10/963,332), contacting the hair with a developer mixture comprising a mixture of a peroxide and a basifying compound as claimed in claims 1 and 10 (see claims 1 and 9 of the copending Application No. 10/963, 332), the method wherein further applying to the hair an aligning and distributing means after the hair has been contacted with the oxidative

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hair dye as claimed in claims 11-12 (see claims 11-12 of the copending Application No. 10/963,332). Therefore, this is an obvious formulation.

Although, the claims of the copending Application No. 10/963,332, teach and disclose similar hair dyeing methods, they are not identical to the instant claims, because the claims of the copending Application No. 10/963,332, require a fatty component of components having at least one fatty amine, while the instant claims do not require such a limitation. Therefore, the conflicting claims are not identical.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize such a method for dyeing hair because the claims of the copending Application No. 10/963,332, teach and disclose similar method for dyeing hair wherein the oxidative dye mixture is applied to the hair first followed by application of the developing mixture that comprises peroxides and persulfates as claimed, thus, a person of the ordinary skill would be motivated to utilize such a method for dyeing hair and would expect such a method to have similar properties and similar effect to the hair as those claimed, absent unexpected results.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3        Claims 1-5, 10, 13, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarojini et al. (US 2003/0154562 A1).

Sarojini et al (US' 562 A1) teaches a method for coloring hair comprising applying to the hair a mixture of oxidative dye precursors such as para-phenylenediamine followed by contacting the hair with a mixture of oxidizing agents such as peroxide and persulfates as claimed in claims 1-4 (see page 10, claim 1 and page 5, paragraph, 0096), the method wherein the primary intermediates are presented in the amounts of 0.001 to 5% which overlapped with the claimed range as claimed in claim 5 (see page 2, paragraph, 0041), the method wherein the oxidizing mixture comprising hydrogen peroxide as claimed in claim 10 (see page 5, paragraph, 0096). Sarojini et al. (US' 562 A1) also teaches similar kit as claimed in claims 13 and 16 (see paragraph, 11, claim 17).

The instant claims differ from the reference by optimizing the weight ratio of persulfate salt to peroxide to be in the range of 1 to about 4 as claimed.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a composition for dyeing hair by optimizing the dyeing ingredients in the composition in order to get the maximum effective amounts because the reference clearly teaches that the oxidizing compounds are presented in the percentage amounts of 0.1 to 1.5% (see page 3, paragraph, 0062) and a mixture of oxidizing compound may be used (see page 5, paragraph, 0096), and thus a person of the ordinary skill in the art would be motivated to optimize the oxidizing compounds in the dyeing composition in order to get the maximum effective amounts, absent unexpected results.

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4        Claims 11,12 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarojini et al. (US 2003/0154562 A1) in view of Dias (US 6,540,791 B1)

The disclosure of Sarojini et al. (US' 562 A1) as described above, does not teach or disclose the aligning and distributing means as claimed.

Dias (US' 791 B1) in analogous art of hair dyeing formulation, teaches a method for dyeing hair comprising applying to the hair a distributinh means such as comb and brush (see col. 49, lines 25-27)

Therefore, in view of teaching of the secondary reference, one having ordinary skill in the art at the time the invention was made to apply to the hair an aligning and distributing means such as brushes or combs with a reasonable expectation of success because Dias (US' 791) clearly teaches that the composition may be applied directly to the hair or via some vehicle such as brushes, combs or applicators (see col. 49, lines 25-27), and, thus, a person of the ordinary skill in the art would be motivated to apply such a vehicle as taught by Dias (US' 791 B1) in the method described be Sarojini et al. (US' 562 A1) and would expect such a method to have similar properties to those claimed, absent unexpected results.

***Allowable Subject Matter***

5        Claims 6-9 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art do not teach or disclose the claimed limitations.

***Conclusion***

6        The references listed on from 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the

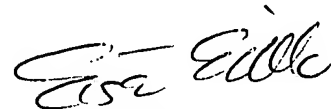
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rejection above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B. Elhilo whose telephone number is (571) 272-1315. The examiner can normally be reached on M - F (8:00 -5:30) with alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eisa Elhilo  
Patent Examiner  
Art unit 1751

August 2, 2005